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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,398

03/31/2006

Ian Taylor

5176

7428

35969

7590

07/06/2007

JEFFREY M. GREENMAN

BAYER PHARMACEUTICALS CORPORATION

400 MORGAN LANE

WEST HAVEN, CT 06516

EXAMINER

BABIC, CHRISTOPHER M

ART UNIT

PAPER NUMBER

1637

MAIL DATE

DELIVERY MODE

07/06/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10574398	3/31/2006	TAYLOR ET AL.	5176

JEFFREY M. GREENMAN  
BAYER PHARMACEUTICALS CORPORATION  
400 MORGAN LANE  
WEST HAVEN, CT 06516

**EXAMINER**

Christopher M. Babic

**ART UNIT****PAPER**

1637

20070702

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

Commissioner for Patents

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election of group I, claim(s) 1-3, and the probe array is acknowledged. However, the reply filed on April 17, 2007 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Applicant did not elect a single combination of sequences as required by the restriction requirement. As set forth in the previous restriction requirement, for an elected group, Applicants must further elect a **single** combination of nucleotide sequence. For example, Applicants must elect a single combination (i.e., 20, 100, 200 or 366 genes) of genes and identify the genes of the combination in the claims. Applicant is further advised to select a combination of sequences that include any sequences Applicant believes to be free of the prior art. If one elected sequence is found to be allowable, any permutation of combination comprising the SEQ ID NO would be allowable.

The above restriction practice is supported by MPEP 803.04, example (c), wherein the section states:

"Applications containing only composition claims reciting different combination of individual nucleotide sequences...**will be** subject to a restriction requirement. Applicants **will be** required to select **one combination** for examination. If the selected combination contains **ten or fewer sequences, all of the sequences of the combination will be searched**. If the selected combination contains more than ten

sequences, the combination will be examined following the procedures set forth above for example (B)”

Example (B) states that the presence of one novel and non-obvious sequence within the combination will render the entire combination free of prior art (MPEP 803.04).

Therefore, Applicants must elect a **single combination** of polynucleotide (or gene) sequences to which the claimed combination comprises. Further, Applicants are advised to identify the sequences (or genes) (within the combination) which are least likely to be found in the prior art, for the examination to be facilitated.

Applicants have submitted that the above restriction requirement is improper because the elected invention is a method of using the recited gene sequences, rather than a composition claim as discussed in MPEP 803.04. This argument is not persuasive because each gene sequence and/or combination of gene sequences, i.e. group of SEQ ID NOs, comprises a patentably distinct combination. Therefore, each method that requires a patentably distinct combination is patentably distinct from each other.

Additionally, it is noted that the requirement for an election of a single combination of sequences is for the purpose of reducing the burden of search, and not to preclude Applicant from utilizing additional sequences to enable the methods claimed. As set forth above, the presence of one novel and non-obvious sequence renders **any** combination of sequences including that novel and non-obvious sequence free of the prior art. The requirement for an election of a single combination of

sequences stands. See 37 CFR 1.111. Since the above-mentioned reply appears to be bona fide, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Babic whose telephone number is 571-272-8507. The examiner can normally be reached on Monday-Friday 7:00AM to 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/574,398  
Art Unit: 1637

Page 5

Christopher M. Babic  
Patent Examiner  
Art Unit 1637

*Am* *[Signature]*  
7/2/07

*Gary Benzion*  
GARY BENZION, PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600